

REMARKS

Applicants thank the Examiner for her time and consideration in a formal interview conducted December 20, 2005. Those discussions were useful in formulating the amendments presented in the present Response. It is understood that this case has been reassigned to a new Examiner, and so references below to actions by “the Examiner” should be interpreted to mean “the *previous* Examiner.”

Claims 9-16 and 24-30 and 35-38 were examined. All claims were rejected. In response to the above-identified Office Action, Applicants amend claims 9 and 24, but do not cancel any claims or add any new claims. Reconsideration of the rejected claims in light of the aforementioned amendments and the following remarks is requested.

I. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 15, 16, 24-28, 35 and 37 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application No. 2002/0138471 by Dutta *et al.* (“*Dutta*”) in view of U.S. Patent Application No. 2004/0193900 by Nair (“*Nair*”).

Claim 9 recites a system for tracking file storage on a peer-to-peer (“P2P”) network comprising several elements, including a transfer device adapted to passively transfer a list of shared files from each computer of a plurality of computers and store the list of shared files in a database. At least this element is absent from the references of record. Applicants draw the Examiner’s attention particularly to the underlined portion of the claim: in the claimed system, the database contains a list of shared files. *Dutta*, by contrast, teaches storing search keywords and peer identifiers in the database. (*See, e.g.* Fig. 3: client rating database 324 contains completed search keywords 326, retrieved file usage statistics 328, and peer node rating values 330. Also Fig. 4: client rating database 418 stores keywords and node identifiers.) Lists of shared files are different from search keywords and peer identifiers.

The secondary reference, *Nair*, is only relied upon for a minor point: the Examiner concedes that *Dutta* does not teach passive transfer without any action required from any user. *Nair* allegedly supplies this defect. However, the “passive” action *Nair* discusses is

actually a peer computer broadcasting its list of shared files to a centralized computer. The broadcast would be of no value to *Dutta*, since the purpose of *Dutta*'s system is to maintain rankings of peer computers *in connection with previously-executed queries*. Lists of files are useless to *Dutta* without a query that produced the list. The operational principles behind the two systems are incompatible: *Dutta* works by monitoring P2P queries and responses and storing certain information about them, while *Nair* mentions a "push" (broadcast) system that provides information *Dutta* does not need.

Applicants recognize that *Nair* suggests a centralized computer that receives broadcasts of lists of files and maintains an index of those files, so the Examiner might consider reversing the primary and secondary references. However, this analysis also fails to produce a *prima facie* case of obviousness, since (as explained above) *Dutta* and *Nair* have different and incompatible operational principles. Furthermore, although *Nair*'s "centralized computer" could collect lists of files shared by the peers that broadcast those lists to it, *only* the centralized computer could collect the list. *Nair*'s "method" for creating a database of shared files only works for one computer, and requires none of the other elements recited in claim 9. (For example, if the peers broadcast their lists to the centralized computer, then there is no "query device adapted to request a list of shared files from a plurality of computers connected to the network," as claim 9 recites.

For at least the foregoing reasons, Applicants respectfully submit that claim 9 is not obvious over the references of record, and request that the Examiner withdraw the rejection.

As to claims 10-12, 15 and 16, those claims depend directly or indirectly upon claim 9, and are patentable for at least the reasons discussed in support of that claim. Applicants respectfully request that the Examiner withdraw the rejections of these claims as well.

Claim 24 recites a method of tracking file storage on a file-sharing or peer-to-peer network, comprising a number of operations including requesting a listing of a library of shared files from each of a plurality of computers connected to the network and storing

the listing in a database. *Dutta* does not teach storing the listings in a database (as discussed above, *Dutta* stores query keywords and node identifiers), and *Nair*'s alleged teaching of passive transfer cannot properly be combined with *Dutta*. Therefore, Applicants submit that claim 24 is allowable over the references of record and request that the Examiner reconsider and withdraw the rejection.

As to claims 25-28, those claims depend directly or indirectly upon claim 24, and are patentable for at least the reasons discussed in support of their base claim. For at least those reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 25-28.

Claim 35 recites a method comprising several steps, including requesting a list of files shared by each of a plurality of computers; and storing the obtained plurality of lists of shared files in a database. The Examiner rejected this claim over several citations to portions of *Dutta*, but (as discussed above) that reference does not store lists of shared files in a database. The paragraph of *Dutta* cited for that limitation, [0071], shows this clearly:

At some point during the search process, although most likely after files have been retrieved, **keywords 414** in the search query and associated peer **node identifiers** are indexed into **client rating database 418**.

Also, inexplicably, the Examiner states that "*Dutta* does not explicitly teach a peer-to-peer network," and relies on *Nair* for that. Of course, *Dutta* does teach such a network, but neither of the references of record teach or suggest at least the claim limitations mentioned above.

Applicants respectfully request that the Examiner withdraw the rejection of claim 35, since no *prima facie* case has been established.

Claim 37 recites a system comprising a query computer coupled to a network to issue a query to a plurality of peers of a peer-to-peer network and to issue a download request to a peer of the peer-to-peer network; a monitor computer coupled to the network to block the download request from the query computer; and a database to store a copy of

the download request. The Examiner rejected this claim over citations to *Dutta* ¶¶ 0059-0060, but those paragraphs lack any mention of a monitor computer to block the download request from the query computer, and of course *Dutta*'s database stores search keywords and peer ratings, not download requests. Again, the Examiner states that *Dutta* does not teach a peer-to-peer network (it does) and a database to store a copy of the download request, and relies on *Nair*. However, even if the references were compatible, *Nair* does not store download requests in its "index of files." Applicants respectfully submit that the rejection of claim 37 is inadequately supported and request that the Examiner withdraw it.


The Examiner rejected claims 13, 14, 29, 30, 36 and 38 under 35 U.S.C. § 103(a) as unpatentable over *Dutta* (*supra*) and *Nair* (*supra*), in view of U.S. Patent Application No. 2003/0105831 by O'Kane ("*O'Kane*"). The rejected claims depend directly or indirectly upon one of claim 9, claim 24, claim 35 or claim 37, base claims which were discussed and shown to be patentable over the cited references in the preceding paragraphs. *O'Kane* is relied upon for teachings related to report preparation, but even assuming for the sake of argument that *O'Kane* contains the alleged material, and that it may properly be combined with *Dutta* and *Nair*, Applicants have been unable to locate any teaching or suggestion in *O'Kane* that provides the material previously noted to be missing from *Dutta*, or that explains how *Nair* might be combined with *Dutta*. Thus, for at least the reasons discussed in support of claims 9, 24, 35 and 37, Applicants respectfully submit that claims 13, 14, 29, 30, 36 and 38 are also allowable over the references of record, and request that the rejections be withdrawn.

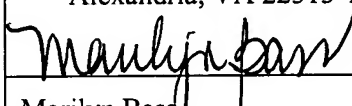
CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 9-16, 24-30 and 35-38, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

In the event that the Examiner locates additional or different relevant art and issues new rejections, Applicants wish to point out that claims 35-38 have not been amended in this Response, so a Final Office Action rejecting those claims would be premature.

Dated: January 5, 2006 Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP


Farzad E. Amini, Reg. No. 42,261

| | | | |
|---|--|--------------|------|
| <p>12400 Wilshire Boulevard Seventh Floor Los Angeles, California 90025 (310) 207-3800</p> | <p style="text-align: center;"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that the correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:</p> <p style="padding-left: 40px;">Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p> 01-05-06</p> <table border="0" style="width: 100%;"><tr><td style="width: 60%;">Marilyn Bass</td><td style="width: 40%; text-align: right;">Date</td></tr></table> | Marilyn Bass | Date |
| Marilyn Bass | Date | | |